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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,748	09/05/2003	Steven M. Gorelick	A0090-285710	9064
23370	7590	10/19/2005	EXAMINER	
JOHN S. PRATT, ESQ KILPATRICK STOCKTON, LLP 1100 PEACHTREE STREET ATLANTA, GA 30309			CAPUTO, LISA M	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/656,748	GORELICK, STEVEN M.	
	Examiner	Art Unit	
	Lisa M. Caputo	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>08/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Amendment

1. Receipt is acknowledged of the amendment filed 8 August 2005.

Claim Objections

2. Claims 1 and 17 are objected to because of the following informalities:

Regarding claims 1 and 17, the applicant distinguishes that different steps are taken when there is a determination made between a "financial instrument" and a "billing instrument" but does not clearly enumerate examples of these instruments within claims 1 and 17. The claims are objected to because a billing instrument is interpreted to be a subset of a financial instrument as known in the art (i.e. each billing instrument is a financial instrument, but each financial instrument is not a billing instrument), hence clarification is necessary.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Han (U.S. Patent Application Publication No. 2003/0093293) in view of Webb et al. (U.S. Patent Application Publication No. 2002/0120513, from hereinafter "Webb").

Han teaches a transaction system including a method and apparatus for levying a surcharge as a result of a self-service terminal transaction. The surcharge may be paid in part or in full to a charity. Regarding claim 1, Han teaches a method for determining a monetary contribution from an instrument associated with a donor, comprising the receiving of an instrument at an ATM 12, determination of a currency amount of the instrument (box 20), and determining a monetary contribution which is collected into a target account associated with a recipient (box 26) (see Figures 1-2, paragraphs 7, 20-21, and 25-30).

Regarding claims 1, 3-5, 15-17, 19-21, 29, 31, 39, and 41, Han does not teach the step of determining whether the instrument is a billing instrument or a financial instrument, and the further step that if the instrument is a financial instrument, the currency is rounded downward to a lower currency amount, wherein the difference of the values is the contribution, and if the instrument is a billing instrument, the currency is rounded upward to a higher currency amount, wherein the difference of the values is the contribution.

Webb teaches a patronage incentive saving system and method for retail businesses. Webb teaches that the "Round-It" software program is implemented to "round up" their purchase price to the next dollar amount or higher at a point of sale terminal 1004, where the money is then credited electronically to a personalized on-line "Round-It" account (1008), which can be used in mutual funds (1010), or in this embodiment, a charity account (see Figures 6-7, paragraphs 4, 26-31, and 144-156).

In view of the teaching of teaching of Webb, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a determination step to determine what kind of transaction that the machine is receiving since this is an all important step in the transaction since it details what further happens. In addition, it would have been obvious to one of ordinary skill in the art at the time the invention was made to round the monetary amount up in order to be able to make a contribution because this is an easy and efficient step to obtain authorization for extra money since an authorization is already being approved (i.e. the money is already in transaction for a payment, so earmarking the money at this step is easy). This is also favorable because the user is able to make a contribution without having to do more unnecessary paperwork etc. Although Webb does not specifically teach the step of rounding down, it is also obvious to round down when receiving money because again, it is efficient to be able to release the money to a charity account before the user receives it so they will not have to make a contribution later. In addition, rounding is a typical math function that works both in an upward and downward fashion.

Regarding claims 2, 18, 30, and 40, Han teaches that it is determined whether an authorization exists for determining a monetary contribution from the instrument, and if authorization exists, proceeding with determining a monetary contribution (box 26) (see Figure 2, paragraph 7).

Regarding claims 6-8, 25-26, 36, and 46, Han discloses that the financial instrument is selected from a group consisting of an ATM card deposit (in ATM 12), among others, and that the billing instrument is selected from the group consisting of a

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bill, among others, when it is taught that different transactions can be done at a terminal with provisions for charity, including ATM transactions and paying of a bill for a sales transaction at a point of sale, etc. (box 22) (see Figure 2, paragraph 19).

Regarding claims 9, 27, 37, and 47, Han teaches that the monetary contribution is selected from a group consisting of a charitable contribution (box 26, box 28), among others (see Figure 2, paragraph 26).

Regarding claims 10-11, 22, 32-33, and 42-43, Han teaches that the monetary contribution is supplemented with an additional currency amount in the form of a multiple of the monetary contribution when it is taught that different charities can be selected and donated to in different, varying amounts (see Figure 2, paragraphs 28-30).

Regarding claims 12-13, 23-24, 34-35, and 44-45, Han teaches that a notification is provided with the monetary contribution, which could be a message sent to an entity associated with a target account (box 28) (see Figure 2, paragraphs 26-29).

Regarding claims 14, 28, 38, and 48, Han teaches that there are instructions to automatically collect a monetary contribution for a predefined period of time, for example, monthly, at the ATM 12 (see Figure 1, paragraph 26).

Response to Arguments

4. Applicant's arguments filed 8 August 2005 have been fully considered but they are not persuasive.

Regarding applicant's arguments that Han does not teach the rounding of money for a contribution, examiner respectfully submits that the office action recites this and supplies the additional art of Webb in order to overcome this limitation.

In response to applicant's argument that Webb teaches a rounding program in order to send money to a savings account for the user and not a donation to a third party recipient, examiner respectfully submits that the primary reference of Han teaches that a money is sent to a donation account, and Webb is used to show that it is conventional to be able to round monetary contributions and send the excess to an account. Further, it is respectfully submitted that Webb is an appropriate reference to combine with Han because Webb is indeed teaching the rounding of money that is sent to an account, and it is well known in the art that accounts can be set up for many art-recognized equivalent purposes (i.e. a savings account or a donation account, etc.).

In response to applicant's argument that Webb like Han does not teach the distinction between a billing instrument and a financial instrument, examiner respectfully submits that Webb teaches a purchase transaction step, which is well known in the art to be a type of a billing instrument, and hence, a financial instrument as broadly claimed and interpreted. The determination step occurs with the type of transaction being performed.

In response to applicant's argument that Webb does not teach the limitation of rounding an amount downward, examiner respectfully submits that rounding is a typical math function that is performed in both directions, and hence a monetary amount is able to be rounded both upward and downward.

In response to applicant's argument that the references are not able to be combined because Han relates to making a donation and Webb relates to saving money, examiner respectfully submits that in both references money is subjected to a

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determination step and then sent to an account, whether that be a savings or donation account, which are art-recognized equivalent destinations since the money is being kept in a single place.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: U.S. Patent Application Publication No. 2002/0062173 to Gzybowski which teaches a method and apparatus for operating a vending machine to divert charitable contributions.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Lisa M. Caputo** whose telephone number is **(571) 272-2388**. The examiner can normally be reached between the hours of 8:30AM to 5:00PM Monday through Friday. If attempts to reach the examiner by telephone are

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unsuccessful, the examiner's supervisor, Michael G. Lee can be reached at (571) 272-2398. The fax phone number for this Group is (571) 273-8300.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [lisa.caputo@uspto.gov].


All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



LMC

October 14, 2005


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